

Attorney Docket No.: P-457 (TI-0018)
Inventors: Gjerde et al.
Serial No.: 09/826,055
Filing Date: April 3, 2001
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REMARKS

Claims 34-73 are pending in this application. Applicants are respectfully requesting reconsideration of the restriction requirement. No new matter has been added.

The Examiner has made a restriction requirement under 35 U.S.C. §121 as follows:

Group I, claims 34-47, 52-65, and 68-73, drawn to a method of polynucleotide detection using a covalently bound tag, classified in class 210, subclass 656; and

Group II, claims 48-51, 66 and 67 drawn to polynucleotide detection using a DNA binding tag, classified in class 435, subclass 6.

The Examiner suggests that Group I and Group II are unrelated. It is suggested that the mechanism of Group I involves the covalent binding of tag whereas Group II involves the reversible binding of intercalating dye. The Examiner also suggests that the search required for Group I is not the same as the search required for Group II and that restriction is proper. Applicants respectfully traverse this rejection.

The criteria which must be met for a restriction requirement to be proper are set forth in MPEP §803 and include: (1) that the inventions be independent or distinct and (2) that there would be

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a serious burden on the Examiner if the restriction is not required. MPEP 802.01 defines "distinct" to mean that the "two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made there, etc., but are capable of separate manufacture, use, or sale, as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER."

Clearly both groups I and II, are methods for enhancing the detection of a polynucleotide separated by reversed phase ion pairing chromatography. Thus, both groups contain claims with the same technical features.

Further, Applicants respectfully disagree with the Examiner's suggestion that there would be a burden on the Examiner if the restriction is not made due to additional searching. Clearly any search performed to identify art relating to Group I's enhanced detection of a polynucleotide separated by reversed phase ion pairing chromatography would also identify any relevant art to claims set forth in Group II. Thus, the inclusion of both groups for prosecution in this application would result in no additional burden on the Examiner.

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Accordingly, since the instant restriction requirement fails to meet either of the two criteria for proper restriction, withdrawal of the requirement is respectfully requested.

However, Applicants have been advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed. Accordingly, Applicants elect Group II for examination, with traverse.

Respectfully submitted,

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